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In re Application of
 Srinka Ghosh
 Serial No.: 10/773,890
 Filed: February 6, 2004
 Attorney Docket No.: 10030771-1

PETITION DECISION

This is in response to the petition under 37 CFR 1.144, filed September 24, 2007, requesting withdrawal of an improper restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 on February 6, 2004, and contained claims 1-26. In a first Office action, mailed August 30, 2006, the examiner required restriction, as follows:

Group I – Claims 1-14 and 25 drawn to a method of processing microarray data;
 Group II – Claim 15 drawn feature signal data; and
 Group III – Claims 16-24 and 26 drawn to a system for processing microarray data.

An election of species was also required for Group I, if elected.

The examiner reasoned that the system (apparatus) and method of use were separate and distinct inventions and were also different from the raw data of Group II.

Applicants replied on October 16, 2006, electing Group III with traverse. Applicants argued that the examiner has failed to establish that Groups I and III were separate and distinct and that the same process steps were employed in both and there would be no burden to consider both together.

The examiner mailed a new Office action to applicants on May 22, 2007, acknowledging the election of Group III, but maintaining the requirement and making it Final. The examiner maintained the argument that the process and apparatus claims were distinct inventions. Claims

16-24 and 26 were then rejected under 35 U.S.C. 112, second paragraph, as indefinite and explained why. Claims 16-24 and 26 were also rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. Finally, claims 16-24 and 26 were rejected under 35 U.S.C. 102(a) as anticipated by Bozinov.

This petition was filed on September 24, 2007, and traverses the finality of the restriction requirement as in error. **Note** - Applicants indicate that a reply to the merits of the Office action was filed on August 22, 2007, but such reply cannot be found in the file and should be resubmitted with evidence of prior submission to avoid extension of time fees.

DISCUSSION

Applicants' petition appears to be primarily directed to the restriction between Groups I and III and that since the same four process steps appear in each independent claim they should be examined together since a search for the process steps would be required for each one. Further, the only significant difference between the claim sets is the presence of a processor (i.e. a computer) which does not lend novelty to the claim set. A review of applicants' arguments and the claim sets involved show applicants' arguments to be correct. In view thereof the Groups should be examined together.

Applicants also briefly traverse the restriction with respect to Group II. A review of Claim 15 (Group II) shows that it is directed to a data set only and is considered non-statutory as it stands. In view of this it will not be rejoined with Groups I and III.

DECISION

The petition is **GRANTED**. The restriction requirement between Groups I and III is withdrawn and these claims will be examined together. Any response should address the rejections of record as if they applied to all of the claims of these two Groups.

Applicants remain under obligation to reply to the Office action mailed May 22, 2007, within the time period set therein or as extended under 37 CFR 1.136(a), (unless such response has been filed – see note above).

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.



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